



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 32

THOMAS THOMPSON
92-543 KOKOLE PLACE
MAKAKICO HI 96707

COPY MAILED

SEP 22 2004

OFFICE OF PETITIONS

In re Application of :
Thompson :
Application No. 09/396,128 :
Filed: September 14, 1999 :
Attorney Docket No. N/A :
For: HURRICANE-EARTHQUAKE FRIEZE :
PLATE :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed August 23, 2004 (certificate of mailing date August 17, 2004), to revive the above-identified application.

The petition under 37 CFR 1.137(b) is **dismissed**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. If petitioner responds within two months of the mail date of this decision, no additional fee will be due. However, if petitioner takes longer than two months to submit a reconsideration petition, petitioner will need to purchase extensions of time under 37 CFR 1.136(a). The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." Petitioner is advised that this is not a final agency decision.

A non-final Office action was mailed on June 26, 2002, which set an extendable 3 month period for reply. Petitioner filed an amendment with a one month extension of time on November 4, 2002 (certificate of mailing date October 26, 2002). The above-identified application became abandoned for failure to timely submit a reply to the letter of Informality Re Payment of Fee, mailed November 21, 2002, which required applicant to submit \$114 in excess claim fees owed within the original period set in the June 26, 2002 non-final Office action or within one month of the mail date of the November 21, 2002 letter, whichever was longer. A reply was received on February 5, 2003, but the reply was untimely. This application became abandoned on December 22, 2002. A Notice of Abandonment was mailed on March 12, 2003. Applicant's first petition to withdraw the holding of abandonment, filed August 14, 2003 and supplemented on October 19, 2003, was dismissed on April 27, 2004. Applicant's second petition to withdraw the holding of

abandonment, filed May 5, 2004, was dismissed on June 2, 2004. Applicant's petition to revive under 37 CFR 1.137(a), filed May 10, 2004 (certificate of mailing date May 5, 2004), was dismissed on July 14, 2004 for failure to show the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

The provisions of 37 CFR 1.137(b) provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) the required reply, unless previously filed;
- (2) the petition fee as set forth in 37 CFR 1.17(m);
- (3) a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and
- (4) any terminal disclaimer (and fee set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

Regarding (1) above, petitioner has not properly responded to the November 21, 2002 letter of Informality Re Payment of Fee. Petitioner once again argues that the \$114 fee required for the eight claims in excess of the twenty previously paid for and for the fourth independent claim is mistaken. Petitioner argues that the USPTO clerk miscounted the number of claims submitted in the November 4, 2002 (certificate of mailing date October 26, 2002) amendment. Petitioner asserts that only claims 20-39, twenty claims, including two independent claims, are pending.

Petitioner is reminded that Examiner Tran did not cancel claims 1-19 in the June 26, 2002 non-final Office action. The June 26, 2002 non-final Office action clearly states that Claims 12-31 are pending and the Detailed Action points out that it appeared applicant's intent was to cancel claims 1-19 and then add new claims, but the March 4, 2002 CPA requested that the Office cancel only claims 1-11 and add claims 12-31. For the purposes of examination, Examiner Tran renumbered the new claims as 20-39. Examiner Tran requested clarification of petitioner's intent.

Rule 126 states that when claims are added, they must be numbered consecutively beginning with the number next following the highest numbered claim previously presented. Examiner Tran followed this rule, but he did not cancel any claims beyond the requested claims, numbers 1-11.

Petitioner never requested that Examiner Tran cancel claims 12-19. Petitioner did not include a parenthetical expression following the claim number indicating the status of the claim in the November 4, 2002 (certificate of mailing date October 26, 2002) amendment. Petitioner did include a marked up version of claims 12-19. 37 CFR 1.121(c)(1)(ii) states that a marked up version does not have to be supplied for an added claim or a canceled claim as it is sufficient to state that a particular claim has been added, or cancelled. In short, petitioner did not follow claim amendment rules.

Upon submission of an amendment (whether entered or not) affecting the claims, payment of fees for those claims in excess of the number previously paid for is required. The additional fees due with an amendment are calculated on the basis of the claims which would be present if the amendment were entered. The November 4, 2002 (certificate of mailing date October 26, 2002) amendment left 4 independent claims and eight claims in excess of the twenty previously paid for.

The \$114 fee was and is properly required. This is the required reply in any future petition to revive.

With respect to finances, petitioner paid a \$1,330.00 large entity petition fee. However, petitioner has paid small entity fees throughout prosecution. Petitioner has not changed entity status to large entity. Therefore, the Office will charge only a \$665.00 small entity petition fee. A treasury check for \$665.00 will be scheduled shortly.

Regarding petitioner's request for a refund of the petition fee, the payment of the petition fee is a prerequisite to the filing of a petition to revive under 37 CFR 1.137(b). This requirement cannot be waived. MPEP 711.03(c)(III)(B).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop Petition
Crystal Plaza 2, Lobby, Room 1B03
Arlington, VA 22202

By FAX: (703) 872-9306

Telephone inquiries may be directed to the undersigned at (703) 308-6712. After September 27, 2004, please call (571) 272-3230

A handwritten signature in black ink, appearing to read "E. Shirene Willis". The signature is written in a cursive, flowing style.

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions